

Application No.: 10/014,950
Amendment and Response dated December 24, 2003
Reply to Office Action of September 24, 2003
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REMARKS

Elections/Restrictions

The application is subject to a restriction requirement. The Examiner requires restriction among the species of the claimed invention as shown in Groups I-II, claims 1-8 and 14-21, drawn to a process of making taxane, classified in class 549, subclass 510 and claims 13 and 26 drawn to an acid ester, classified in class 560, subclass 19.

Applicants confirm the previous election to prosecute Group I, claims 1-8 and 14-21. However, Applicants reserve the right to prosecute the non-elected claims of Group II, claims 13 and 26 at a later date.

Status of Claims

Claims 1-8 are currently pending. Claims 13 and 26 have been withdrawn and claims 14-21 have been cancelled without prejudice. Applicants reserve the right to pursue the subject matter of claims 14-21 in a continuation application.

Section 103 Rejections

Claims 1-8 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,615,739 to Mas et al. ("Mas.") This rejection is respectfully traversed.

Claims 1-8 are directed to a method of preparing a side-chain bearing taxane by coupling a taxane moiety to an oxazolidine derivative. Although Mas uses similar starting materials, i.e., an oxazolidine derivative and taxane moiety, the methods of Mas and the present claims are significantly different.

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Mas teaches the step of replacing protecting groups which are present on the hydroxyl and amino functions with hydrogen atoms subsequent to esterifying baccatin III or 10-decacetylbaccatin III with the acid of formula VII, which includes the amine function protecting group. See Mas, Column 3, lines 35-50. Then, an additional step of introducing substituent R₁ to the amine function is required to achieve the desired taxane derivative. See column 4, lines 12-15. The present invention avoids this additional step.

In the present invention, the desired substituent, R¹ is already present on the amine function of the oxazolidine ring and remains bonded to the amine substituent after the opening of the ring. The protecting groups need not be removed as required by Mas. Mas does not teach or suggest a method of preparing a side-chain bearing taxane as in the present claims in which the opening of the ring directly results in achieving the desired taxane compound as in the present invention. Therefore, reconsideration and withdrawal of the rejections of claims 1-8 in view of Mas are appropriate and respectfully requested.

Claims 14-21 have been rejected under 35 U.S.C. §103(a) in view of U.S. Patent No. 5,637,723 to Commercon et al. Applicants respectfully submit that the cancellation of claims 14-21 obviates these grounds of rejection. However, Applicants reserve the right to prosecute these claims in a continuation application.

In view of the amendments and remarks set forth above, reconsideration and withdrawal of the rejections are appropriate and respectfully requested. Applicants submit the present claims are patentably distinct over the art and allowable in form. Early allowance is therefore solicited. The Examiner is encouraged to contact the undersigned attorney should there be any questions regarding this amendment.

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